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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,702	12/31/2001	Jayantilal Devabhai Patel	1477	4988
27310	7590	03/19/2004	EXAMINER	
PIONEER HI-BRED INTERNATIONAL INC. 7100 N.W. 62ND AVENUE P.O. BOX 1000 JOHNSTON, IA 50131			KUBELIK, ANNE R	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding:

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/036,702	PATEL, JAYANTILAL DEVABHAI
	Examiner Anne R. Kubelik	Art Unit 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2 and 43-61 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-2, 43-61 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/17/02</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____

## **DETAILED ACTION**

1. Claims 1-2 and 43-61 are pending.

### ***Claim Objections***

2. Claims 43-44, 46-50, 52-53 and 55-61 are objected to because of the following informalities:

In claims 43-44, 49-50, 52-53 and 58-59, there should be a comma before “wherein”.

In claims 46 and 55 --wherein-- should be inserted after the comma in line 1, and “being of” in line 2 should be replaced with --are from--.

The colon after “of” in claims 46 and 55, line 2, should be deleted.

In claims 47 and 56, line 1, “having” should be replaced with --wherein the plant has--.

In claims 48, 57 and 60-61, “comprising.” should be replaced with --, wherein the method comprises--.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2 and 43-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

Claim 1 lacks antecedent basis for the limitation “said canola variety 45A55” in lines 1-2.

Dependent claims should be amended accordingly.

Claims 45 and 54 are indefinite in their recitation of “tissue culture of protoplasts”, as protoplasts are not tissue cultures.

Claims 46 and 55 are indefinite because the members of the Markush group are not tissue types, but rather are plant parts, and hence do not further define “tissue”. Additionally, the members of the group should either all be recited in the plural or the singular.

Claims 49-50 are indefinite in their recitation of “parent is designated 45A55, ... PTA-5684”. This is confusing, but it is unclear if the claims are intended to indicate that 45A55 is the male or female parent in the cross or if 45A55 is crossed to itself. In the latter case, the claims are not properly dependent upon claim 48, in which 45A55 is crossed to a different canola plant. If the former, wherein the ... PTA-5684” should be replaced with --, wherein 45A55 is the female parent-- in claim 49 and --, wherein 45A55 is the male parent-- in claims 50.

Claim 60 lacks antecedent basis for the limitation “said first generation (f1) canola variety 45A55 progeny canola plant” in part (b).

5. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

The claim is drawn to a method of producing a male sterile canola line comprising crossing 45A55 to a canola plant with cytoplasmic male sterility. However, progeny plants with cytoplasmic male sterility will only be produced if the parent plant with cytoplasmic male sterility is the female parent, as mitochondria are only passed through the egg in canola. Male sterile progeny plants could also be produced if the canola plant with cytoplasmic male sterility also has nuclear male sterility and it would not matter which parent was the female parent in the

cross; however, such a trait would need to be recited in the claim. Thus, the omitted elements are either that plant with cytoplasmic male sterility is the female parent or the plant with cytoplasmic male sterility also has nuclear male sterility.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-2 and 43-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,639,131. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The canola plants claimed in the instant application, 45A55, and the canola plants of claimed in '131, 45A54, have the same traits including flower color (yellow), shedding pollen, plant type (spring), and presence of blackleg and white rust resistance, for example. The canola plants also share similar scores on traits that are affected by environment, e.g., flowering date, plant height, and seed weight, relative to standard canola lines. Applicant has also claimed methods of producing canola plants derived from 45A55 soybean after one cross and using

unspecified second parents. If 45A55 and 45A54 are identical, methods of crossing 45A55 canola would be the same as the methods of crossing prior art canola cultivar 45A54. Thus, the 45A55 canola plant and methods of its use appear to be identical to the 45A54 plant and methods of its use.

Alternatively, if the claimed plants and seeds of the instant invention are not identical to 45A54, then it appears that 45A54 only differs from the claimed plants and seeds due to minor morphological variation, wherein said minor morphological variation would not confer a patentable distinction to 45A55-derived plants. Similarly, the methods of crossing 45A55-derived soybean would be the same as the methods of crossing prior art canola cultivar 45A54 or its progeny. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by 45A54 canola plants and methods of its use.

### ***Conclusion***

8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Rene Jones at (571) 272-0547.

Anne R. Kubelik, Ph.D.  
March 17, 2004



ANNE KUBELIK  
PATENT EXAMINER